



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/409,748 10/01/99 SCHUTZER

D CITI0127

EXAMINER

TM02/0828

GEORGE T MARCOU  
KILPATRICK STOCKTON LLP  
SUITE 800  
700 13TH STREET NW  
WASHINGTON DC 20005

PHAM, H

ART UNIT

PAPER NUMBER

2172

DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/409,748

Applicant(s)

SCHUTZER, DANIEL

Examiner

HUNG Q PHAM

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson [USP 5,649,186].

Regarding to claim 5, Ferguson teaches a computer readable medium for controlling a system, including a client terminal and a server (see col. 6, lines 61-66), the system's operations comprise: "receiving at least one search term at the client terminal; bundling the at least one search term into a first message at the client terminal; forwarding the first message from the client terminal to the server; and issuing the at least one search term as a search request from the server to a search engine" (see col. 3, lines 25-32).

Regarding to claim 3, Ferguson teaches the method of attaching at least one Web page to a first e-mail message by "receiving an address associated with the at least one Web page and retrieving the at least one Web page (see col. 4, lines 63-66) then "bundling the copy of the at least one Web page into the first e-mail message, and forwarding the first e-mail message wherein the copy of the at least one Web page may be reviewed (see Fig. 2A-D, col. 4)".

Regarding to claim 4, Ferguson teaches all the subject matters as discussed in claim 3 and further discloses the step of "generating the address based upon a request to review the at least one Web page (see col. 3, lines 25-30) that is linked to a copy of another Web page (see col. 4, lines 63-67, col. 5, lines 1-7) wherein the copy of other Web page is bundled in a second e-mail message (see Fig. 2A-D, col. 4)".

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C 103(c) and potential 35 U.S.S 102(e), (f) or (g) prior art under 35 U.S.C 103(a).

5. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson [USP 5,649,186] in view of Borman et al. [USP 6,226,655].

Regarding to claim 6, Ferguson teaches all the subject matters as discussed in claim 5, and further discloses the steps of attaching one or more desired Web page

Art Unit: 2172

after the searching to an e-mail message (see Fig. 2A-D, col. 4). Ferguson does not explicitly teach the steps of receiving links to Web pages that are associated with the search term then issuing requests for a sub-plurality of the plurality of Web pages to receive them by the server. Borman et al. teaches the steps of "receiving links to Web pages that are associated with the at least one search term at the server (see Fig. 5A, col. 7-8)", then "issuing requests for a sub-plurality of the plurality of Web pages (see col. 9, lines 34-35)" by utilizing a mouse to receive "the sub-plurality of Web pages by the server (see Fig. 6, col. 8). Thus, the sub-plurality of Web pages can be put in the box 204 of the NewsEditon application window of Ferguson's technique in Fig. 2A for e-mail purpose. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the two techniques into one in order to copy the sub-plurality of Web pages into a plurality of e-mail messages by the server and forwarding the plurality of e-mail messages from the server to client.

Regarding to claim 1, Ferguson teaches the method of attaching at least one Web page to an e-mail message by constructing a template that dictates the type of interested information to get the desired Web pages in the Web then "bundling a copy of the at least one Web page into an e-mail message" and "forwarding the e-mail message wherein the copy of the at least one Web page may be reviewed" (see Fig. 2A-D, col. 4). Ferguson fails to disclose the claimed subject matters of searching. Borman et al. teaches the method of retrieving data from a network by: "receiving at least one search term; issuing a search request to a search engine using the at least one search term (see Fig 4, box 410, col. 7); receiving the hit list from the search engine" (see Fig. 5A,

Art Unit: 2172

col. 7); "retrieving at least one Web page based on the hit list" (see Fig. 6, col. 8). Thus, after performing the searching steps of Borman et al., the NewsEditor 200 (Fig. 2A) of Ferguson will contain the hit list of Borman et al. in box 204 for further manipulation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine two techniques into one in order to attach at least a Web page to an e-mail message.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson [USP 5,649,186] in views of Borman et al. [USP 6,226,655] and Mantha et al. [USP 6,163,779].

Regarding to claim 2, Ferguson and Borman et al. teach all the subject matters as discussed in claim 1 including "bundling a copy of each link between the other Web page and the at least one Web page into the e-mail message" (see Ferguson, Fig. 2A-D, col. 4), except the step of "receiving a number representative of a depth in which the depth is the amount another Web page is removed from the at least one Web page". However, Mantha et al. teaches this claimed subject matter by using the Counter 72 (see col. 10) to count the number of another copied Web page that removed from the home page. Therefore, it would have been obvious to one of ordinary skill in the art to include the counter into the technique in order to know the amount of embedded pages.

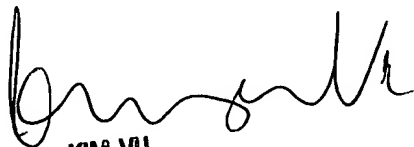
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Pham whose telephone number is 703-605-4242. The examiner can normally be reached on Monday-Friday, 8:00 Am - 4:30 Pm.

Art Unit: 2172

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VU, KIM YEN can be reached on 703-305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-9731 for regular communications and 703-305-9731 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100